

**REMARKS:**

Claim 6 was rejected under 35 U.S.C. §112, first paragraph. In response, claim 6 has been amended regarding Examiner's specific concerns (support being found in at least paragraph [0019] as originally filed) and Applicant submits that those amendments obviate the rejection of the claims under 35 U.S.C. §112, second paragraph and thus ask that the Examiner reconsider and withdraw the rejection of the claims.

Initially, Applicant must view Examiner's rejections as being based, at least in part, on "inherency" in view of the fact that Examiner states, for instance at page 3 of the Official Action regarding claims 1, 3, 4, 6, 7, and 8 that *Gehring* and *Gulistan* "discloses an elongate grounding element for (i.e. capable of) affecting . . ." Regarding anticipation under §102, it is well accepted that "[t]he mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation." Still further, regarding obviousness under §103, it is similarly well accepted that "a retrospective view of inherency is not a substitute for some teaching or suggestion supporting the obviousness rejection."

This being stated, Applicant has affected certain amendments to the claims, not for the purpose of avoiding the prior art, but instead to assist the Examiner in understanding the deficiencies in the relied upon and cited references. From a general perspective, Examiner has very liberally relied upon fastening mechanisms from technologies quite remote from that which has consistently been recited; the same being grounding electrical connections. To avoid confusion, Applicant has amended the apparatus claims to (and added new claims that) specifically recite the inclusion of a grounded support member (24) as an element of the claimed grounding assembly. Regarding the grounded support member (24), it has also been recited that this member is constructed from electrically conductive material and has an aperture therein configured for insertibly receiving at least a portion of the grounding element (1).

Turning to Examiner's several cited references: *Gehring* '503, which is the primary reference in Examiner's rejections of claims 1-7, discloses an invention entitled Opposite Threaded Stud. In pertinent part, *Gehring* '503 discloses the following at column 2, lines 45-68:

**“The integral flange 16 is preferably circular although it also can be a hexagonal configuration as shown in FIG. 2 and extends from the juncture of the shanks with the upper and lower face surfaces 17 and 18 being generally planar to present a flat bearing surface for the attachment member 20 and a torque bearing surface on the workpiece 22.**

It will be noted that the thread convolutions 24 and 26 of the respective shanks 12 and 14 are of opposite hand of rotation so that when an associated threaded fastener such as nut 28 is removed from the upper shank section 12 which is preferably provided with right hand threads it will tend to drive the stud member further into the work aperture 30 of the workpiece rather than to dislodge it from the workpiece. This driving tendency is stopped by the flange 16 bearing against the surface of the workpiece 22 and distributes the torque force along the abutting surface of the workpiece. **The stud member 10 of the present invention is most effectively used in a work aperture 30 of a plastic composition workpiece 22 . . .”**

Given the fact that in *Gehring* ‘503 “[t]he stud member 10 . . . is most effectively used in a work aperture 30 of a plastic composition workpiece 22,” makes it clear that there is no disclosure, suggestion or teaching coming from *Gehring* ‘503 of an electrical grounding assembly (element) as recited by Applicant. Therefore, there is no anticipation of Applicant’s claimed invention (§102) as asserted by Examiner, nor is there any teaching or suggestion in *Gehring* ‘503 that would support any appropriate combination of *Gehring* ‘503 with any other reference disclosing a pertinent electrical grounding assembly (element). These things having been stated, Examiner is respectfully urged to reconsider and withdraw the rejections of claims 1-7 and indicate their allowance in the next paper from the Office.

Regarding Examiner’s rejection of claim 8 based on *Gulistan* under §102, it is reiterated that it is well accepted that “[t]he mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation.” Therefore, Examiner’s assertion of the “capability” of means 38 for enhancing electrically conductive contact is inappropriate. At column 4, lines 46-75 the inclusion of the knurl 38, and the reason for the inclusion of the knurl 38 is explained, more specifically, “resulting in a means that locks the terminal 31 against rotation relative to the panel 40.” But more importantly, at column 5, lines 1-7 it is explained

that in “certain installations, however, it is not permissible to use the design of the terminal 31 because of the embedment of the knurled portion in the panel.” Given the fact that the device of *Gulistan* is an Electrical Terminal, if the knurled feature was for electrical conductivity (as opposed to being a locking means as is specifically and expressly disclosed at line 70, column 4 of *Gulistan*) it would more than likely not be optional as is explained at column 4, lines 1-8. Further more, as Examiner has appreciated in the rejection of claim 9, *Gulistan* “does not explain that the terminal may be used for grounding.” Therefore, it is clear that in the case of *Gulistan*, the situation is such that a “mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation” of Applicant’s recited invention based on *Gulistan*.

New claim 10 even more directly recites that the radially projecting ridges assure “electrical grounding contact between the grounding element (1) and the grounded support member (24),” and is therefore submitted as being allowable for the same reasons stated above.

Claim 9 has been amended to recite (and new claim 11 originally recites) that the grounded support member (24) is a frame member of a vehicle. This feature is clearly not disclosed, taught or suggested in any reference of record, and is therefore respectfully urged as being allowable.

Claims 2-5 have been amended to depend, either directly or indirectly from new claim 11 and are therefore allowable for the same reasons stated, as well as in view of the additional limitations contained therein.

Claim 6 has been amended to recite that non-uniform threads on the grounding element of claim 1 resist an applied nut vibrating loose therefrom (also see initial Remarks hereinabove).

Given the above, Applicant requests that the rejections of the claims be reconsidered and withdrawn, and that Examiner indicate the allowance of the claims in the next paper from the Office.

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The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Order No. 07589.0122.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tracy Druce', written in a cursive style.

Tracy W. Druce  
Patent Attorney  
Reg. No. 35,493  
Tel. 202.293.7333